Remarks:

The above amendments and these remarks are responsive to the final Office action dated September 21, 2005. Prior to entry of this Amendment, claims 2-16, 18-22, 24 and 29 remained pending in the application.

In the September 21, 2005 Office action, the Examiner rejected claims 2–4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,289,211 to Morandotti et al. in view of U.S. Patent No. 5,097,248 to Kumada et al. and further in view of U.S. Patent No. 5,494,562 to Maley et al., rejected claims 5–6, 9–16, 18–20, and 24 under 35 U.S.C. §103(a) as being unpatentable over Morandotti et al. in view of Kumada et al., and rejected claims 7–8, 21–22, and 29 under 35 U.S.C. §103(a) as being unpatentable over Morandotti et al. in view of Kumada et al., as applied to claims 5-6, 9-16, 18-20, and 24, and further in view of U.S. Patent No. 6,936,761 to Pichler.

Although applicant respectfully traverses all of these rejections, in the interest of furthering prosecution of the present application, applicant elects to cancel claims 10 and 11 without prejudice. In view of the amendments above and the remarks below, applicant respectfully requests reconsideration of the application and allowance of the pending claims.

Request for Reconsideration of Finality

Applicant requests that the Examiner withdraw the finality of the action dated September 21, 2005 as premature. Withdrawal of finality is provided by MPEP §706.07(d), which states that "[i]f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection."

MPEP states that second actions on the merits shall be final "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement . . . " *MPEP §706.07(a)* (emphasis added). MPEP further states that a second action on the merits "will not be made final if it includes a rejection on newly cited art . . . of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art." *Id.* In other words, MPEP §706.07(a) provides that if any claim is not amended by applicant to require newly cited art, but is rejected on the basis of such art in the immediately subsequent action, then the action rejecting the claim should not be made final. In the present application, a number of applicant's claims were not amended after the first office action to necessitate a new ground of rejection, but were rejected in the September 21, 2005 Office action based on newly cited art. Therefore, applicant asserts that the finality of the September 21, 2005 Office action is premature and should be withdrawn in accordance with MPEP §706.07(d).

Specifically, in an action dated March 23, 2005, the Examiner rejected claims 2–15, 18–22, 24, and 29 based only on U.S. Patent Application Publication No. 2004/0223021A1 to Farr et al. In a response dated June 23, 2005, applicant submitted a Declaration under §1.131, demonstrating applicant's invention prior to the effective date of Farr et al. (April 28, 2003), and rendering Farr et al. unavailable as prior art. Applicant notes that submission of a §1.131 Declaration is not an amendment of the claims *per se*, and thus cannot itself trigger finality of an action under MPEP §706.07(a). Since each of claims 2–15, 18–22, 24, and 29 was rejected based only on Farr et al., those claims were understood to be otherwise

allowable if written in independent form. However, because none of claims 2–15, 18–22, 24, and 29 were independent as originally filed, applicant found it necessary to rewrite several of them to place them into allowable independent form. Applicant asserts that this does not constitute amendment necessitating new grounds of rejection in the sense of MPEP §706.07(a).

In particular, applicant made no substantive amendments to any of claims 2, 3, 5–11, 18–22, or 24 in the June 23, 2005 response, since each of these claims contains exactly the same features after amendment as prior to amendment. Claims 2, 5, 6, 9, 18, 20, and 24 each were amended into independent form, including all of the features of its base claim and any intermediate claims. These therefore were purely formal amendments. Dependent claims 3, 7, 8, 10, 11, 19, 21, and 22 were not amended, except insofar as the claims from which they depend were amended into independent form. The amendments to claims 3, 7, 8, 10, 11, 19, 21, and 22 therefore also were purely formal. Applicant asserts that formally amending a claim solely to transform the claim from dependent into independent form is not an amendment that can necessitate a new ground of rejection, as required by MPEP §707.07(a) for finality.

However, in the September 21, 2005 Office action, the Examiner rejected claims 3, 7, 8, 21, and 22 based on newly cited art. In particular, the Examiner rejected claim 3 under 35 U.S.C. 103(a) based partially on newly cited U.S. Patent No. 5,494,562 to Maley et al., and rejected claims 7, 8, 21, and 22 under 35 U.S.C. 103(a) based partially on newly cited U.S. Patent No. 6,936,761 to Pichler. Since each of claims 3, 7, 8, 21, and 22 contains exactly the same elements and features after amendment as prior to amendment, applicant believes that these claims were

not "amended by applicant" in the sense intended in MPEP §706.07(a), so that the September 21, 2005 Office action rejecting any of these claims based on newly cited art should not have been made final. Alternatively, applicant asserts that even if claims 3, 7, 8, 21, and 22 were "amended by applicant" in the June 23, 2005 response, these amendments did not lead to substantive changes in the claims, and therefore the new grounds of rejection asserted in the September 21, 2005 Office action were not "necessitated by applicant's amendment of the claims" as §706.07(a) requires for finality.

Since none of claims 3, 7, 8, 21, and 22 were amended by applicant so as to necessitate new grounds of rejection, application believes that final rejection of these claims was improper, and respectfully requests withdrawal of the finality of the September 21, 2005 Office action.

Rejections under 35 USC § 103

Claims 2-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morandotti et al. in view of Kumada et al. and further in view of Maley et al. Applicant traverses these rejections.

The Examiner states that Kumada et al. discloses an electrically conductive coating disposed over an electrically conductive substrate, and states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Kumada et al. into the invention of Morandotti et al. because "[t]he motivation for the skilled artisan in doing so is to gain the benefit of protecting the electrodes" (Office action of September 21, 2005, p. 4). Applicant disagrees, because Kumada does not disclose an electrically conductive coating that functions in the manner of applicant's claimed element, and because

there is no motivation or suggestion in the cited references to make the proposed combination.

Kumada et al. discloses "an insulating coating layer" (col. 2, line 32) "having a property to repel the fluid or liquid to be measured" (col. 2, line 44). Kumada et al. describes the coating as "a dielectric material" (col. 2, line 57) that may be constructed from "silicon resins" (col. 4, line 40) or from "fluorine resins (e.g., tetrafluoroethylene)" (col. 5, line 26). The dielectric coating of Kumada et al. does not anticipate applicant's claimed electrically conductive coating, since dielectric coatings such as silicon resins and fluorine resins are electrical insulators rather than electrical conductors, and thus cannot form an electrically conductive coating.

Furthermore, applicant's electrically conductive coating "functions to increase the effective surface area (and thus the capacitance)" of the coated electrode (application p. 10, line 31). In contrast, as the Examiner notes, the insulating coating layer of Kumada et al. is motivated solely to gain the benefit of protecting the electrodes, i.e. to "prevent corrosion" of the electrodes (col. 3, line 21). Since to increase the capacitance of the electrode, the coating must be a good conductor, the skilled artisan would not find it obvious to combine the teachings of Kumada et al., disclosing an insulating coating configured to protect the electrodes but not to increase their capacitance, with Morandotti et al., disclosing an uncoated electrode, to arrive at applicant's coated electrode having an increased capacitance. Applicant further notes the absence of any motivation or suggestion in the cited references to make the proposed combinations.

The Examiner rejected claims 5–6, 9–16, 18–20, and 24 under 35 U.S.C. §103(a) as being unpatentable over Morandotti et al. in view of Kumada et al., again

stating that Kumada discloses "an electrically conductive coating" (Office action of September 21, 2005, p. 7). Applicant elects to cancel claims 10 and 11 without prejudice, and traverses the rejections of claims 5–6, 9, 12–16, 18–20, and 24 on the same grounds discussed above with respect to the Examiner's rejection of claims 2–4. Since Kumada et al. does not disclose an electrically conductive coating, it would not have been obvious to one skilled in the art at the time of applicant's invention to combine the teachings of Kumada et al. with the teachings of Morandotti et al. to arrive at applicant's claimed invention of an electrode with an electrically conductive coating that functions to increase the capacitance of the electrode.

The Examiner rejected claims 7–8, 21–22, and 29 under 35 U.S.C. §103(a) as being unpatentable over Morandotti et al. in view of Kumada et al., as applied to claims 5–6, 9–16, 18–20, and 24, and further in view of Pichler. Applicant traverses these rejections on the same grounds discussed above with respect to the Examiner's rejection of claims 2–4, 5–6, 9, 12–16, 18–20, and 24. Kumada et al. does not disclose an electrically conductive coating that may function to increase the capacitance of the electrode in the manner of applicant's claimed invention.

Submission of § 1.131 Declaration

In addition to the grounds discussed above, applicant submits herewith a Declaration Under § 1.131, demonstrating applicant's invention prior to the effective date of Pichler (March 29, 2003). Pichler thus is rendered unavailable as prior art, and the rejections of claims 7–8, 21–22, and 29 under 35 U.S.C. § 103(a) based on Pichler should be withdrawn on this basis, as well as on the basis described above.

Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

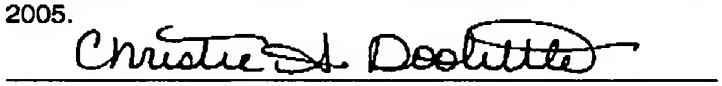
Respectfully submitted,

KOLISCH HARTWELL, P.C.

Walter W. Karnstein
Registration No. 35,565
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicant

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner L. Liang, Group Art Unit 2853, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on November 21, 2005.



Christie A. Doolittle